UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DENISE PELLEY, DANIEL B. SOLAREK,
JUDITH K. WHALEY and RAJAL DHRUVA

Appeal No. 2005-2218
Application No. 09/922,089

ON BRIEF

Before KIMLIN, GARRIS and TIMM, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-19, all of the claims in the present application.

Claim 1 is illustrative:

> 1. A water based adhesive comprising a converted starch derivative having a flow viscosity of between about 7 and about 20 seconds.

The examiner relies upon the following references in the rejection of the appealed claims:

Eden et al. (Eden)	5,688,845	Nov. 18, 1997
Lydzinski et al. (Lydzinski)	6,280,515	Aug. 28, 2001 (filed Jun. 23, 2000)

Appellants' claimed invention is directed to a water based adhesive comprising a converted starch derivative. The adhesive has a flow viscosity of between about 7 and 20 seconds. According to appellants, they "have discovered that the adhesives of the disclosed invention are particularly advantageous for use as seam gum adhesives in the manufacture of envelopes" (page 3 of brief, second paragraph).

Appealed claims 1, 2, and 9-11 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Eden. Claims 1-7 and 10-19 stand rejected under 35 U.S.C. § 102(e)as being anticipated by Lydzinski. Also, claims 1 and 8 stand rejected under 35 U.S.C. § 103(a)as being unpatentable over Eden.

Appellants submit at page 3 of the brief that "[c]laims 2-6 and 8-12 stand or fall with claim 1."

We have thoroughly reviewed each of appellants' arguments for patentability. However, we find that the examiner's rejections are well-founded. Accordingly, we will sustain the examiner's § 102 and § 103 rejections.

Appellants do not dispute the examiner's factual determination that both Eden and Lydzinski disclose water based adhesives comprising a converted starch derivative, and that both

references teach the same compositional components for the adhesives. The principal argument advanced by appellants is that neither reference discloses that the adhesive has a flow viscosity of between about 7 and 20 seconds.

As noted by the examiner, it is well settled that when a prior art composition reasonably appears to be essentially the same as a claimed composition, the burden is on the applicant to establish that the prior art composition does not necessarily or inherently possess the characteristic attributed to the claimed composition. See In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990); In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). To place this burden on an applicant is eminently fair inasmuch as the USPTO is not equipped to test the properties and characteristics of either the prior art or the applicant's composition.

In the present case, we find it particularly fair to place this burden on appellants inasmuch as their assignee, National Starch and Chemical Investment Holding Corporation, is the same assignee for both reference patents to Eden and Lydzinski. Consequently, appellants should be able to ascertain whether or not the water based adhesives fairly described by Eden and

Lydzinski have the claimed flow viscosity of between about 7 and about 20 seconds. In our view, it would not be an unreasonable burden on appellants to place of record the requisite objective evidence which establishes the flow viscosity disclosed by Eden and Lydzinski. In cases such as this, it is simply not enough for appellants to make the argument that references do not teach the claimed flow viscosity.

As for the § 103 rejection of claims 1 and 8 over Eden, we agree with the examiner that it would have been obvious for one of ordinary skill in the art to resort to routine experimentation to determine the optimum flow viscosity for the water based adhesives disclosed by Eden. Eden specifically teaches that the viscosity of the adhesive is a result effective variable that is taken into consideration in a trade off with the molecular weight of the converted starch derivative (see column 2, lines 33 et seq. Eden further discloses that "[a]n inherent problem exists because higher molecular weight dextrins provide excellent adhesion, but the adhesives are extremely high in viscosity and have poor viscosity stability, whereas lower viscosity adhesives contain excessive water (added to achieve acceptable machine viscosities) but, as a result the overall adhesive solids are

lowered" (column 2, lines 57-62). Hence, we are persuaded that one of ordinary skill in the art would have found it obvious to arrive at the claimed flow viscosity during routine optimization. In re Boesch, 617 F.2d 272, 276, 205 USPQ 215, 219 (CCPA 1980). Also, we note that appellants base no argument upon objective evidence of nonobviousness, such as unexpected results, to rebut the prima facie of obviousness.

As a final point, in the event of further prosecution of the subject matter at bar, such as in a continuation application, the examiner should consider a rejection of all the claim under 35 U.S.C. § 103 over Eden and Lydzinski.

In conclusion, based on the foregoing, the examiner's decision rejecting the appealed claims is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED

EDWARD C. KIMLIN)
Administrative Patent Judge)
)
)
BRADLEY R. GARRIS) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
) INTERFERENCES
)
)
CATHERINE TIMM)
Administrative Patent Judge)

EAK/vsh

CYNTHIA L. FOULKE
NATIONAL STARCH AND CHEMICAL COMPANY
10 FINDERNE AVENUE
BRIDGEWATER, NJ 98807-0500